

Notice of Allowability

Application No.

10/035,213

Examiner

Michael J Feely

Applicant(s)

AZECHI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 12/16/03.
2. ☒ The allowed claim(s) is/are 1-10.
3. ☒ The drawings filed on 04 January 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

DETAILED ACTION

Allowable Subject Matter

1. Claims 1-10 are allowed.
2. The following is an examiner's statement of reasons for allowance:

Independent claim 1 and dependent claims 2, 3, and 6-9:

The closest art is Azechi (US Pub. No. 2002/0032270), Fujiki et al. (US Pub. No. 2002/0028335), and the combination of Morita et al. (US Pat. No. 5,530,075) and Meguriya et al. (US Pat. No. 5,714,265).

Azechi and Fujiki et al.: Applicant has provided a certified translation of the foreign priority document associated with this case. This translation fully satisfies the foreign priority requirement and disqualifies Azechi and Fujiki et al. as prior art.

Morita et al. in view of Meguriya et al.: Morita et al. teach the composition of claim 1 comprising: 100 pbw of component A (column 2, line 36; column 3, lines 21-31); component B (column 3, lines 32-43 and 50-62); and 0.1 to 50 pbw of component C (column 2, lines 36-53; column 4, lines 30-40). Morita et al. is silent regarding the concentration of component B being 1 to 100 pbw. In section 7 of the Office action dated April 4, 2003, it was stated that Applicant failed to show criticality of this range. Meguriya et al. was used to demonstrate that this range was a result effective variable, rendering the claim obvious over the prior art.

However, Applicant does actually demonstrate criticality for this range. In the paragraph bridging pages 10 and 11 of the Specification, Applicant states that quantities below this range fail to provide mechanical strength to the composition, whereas excessive amounts present

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difficulty in process-ability. Because the Applicant demonstrates criticality for this range, the prior art has been overcome.

Independent claim 4:

The closest prior art is Azechi (US Pub. No. 2002/0032270) and Fujiki et al. (US Pub. No. 2002/0028335).

Claim 4 was rejected over these references in the Office action dated April 4, 2003, and the rejection was maintained in the Office action dated September 16, 2003. Applicant has provided a certified translation of the foreign priority document associated with this case. This translation fully satisfies the foreign priority requirement and disqualifies Azechi and Fujiki et al. as prior art. As a result, the claim 4 is now allowable.

Independent claim 5:

Claim 5 is allowable for the reasons set forth in sections 8 and 9 of the Office action dated April 4, 2003.

Independent claim 10:

The closest art is Azechi (US Pub. No. 2002/0032270), Fujiki et al. (US Pub. No. 2002/0028335), and the combination of Morita et al. (US Pat. No. 5,530,075) and Meguriya et al. (US Pat. No. 5,714,265).

Claim 10 is equivalent to claim 1, with the exception that it does not recite the bond characteristics set forth at the end of claim 1. Accordingly, claim 10 overcomes the prior art for the same reasons as claim 1.

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Furthermore, Applicant has provided a certified translation of the foreign priority document associated with this case. This translation fully satisfies the foreign priority requirement and disqualifies Azechi and Fujiki et al. as prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Declaration under 37CFR 1.132

3. In the previous response (filed July 3, 2003), Applicant referenced a declaration in their Arguments, addressing the prior art combination of Morita et al. (US Pat. No. 5,530,075) and Meguriya et al. (US Pat. No. 5,714,265); however, the declaration was not submitted with the response. Applicant has included this declaration with the most recent response (filed December 16, 2003).

The declaration under 37 CFR 1.132 filed January 4, 2002 is insufficient to overcome the rejection of claims 1-3 based upon Morita et al. (US Pat. No. 5,530,075) and Meguriya et al. (US Pat. No. 5,714,265) as set forth in the Office action dated April 4, 2003 because: Applicant attempts to show unexpected results by substituting a single component of Morita et al. for "tackifier I" in working example no. 1 of the instant invention. This substitution is made for component (C) of the instant invention. The experiment isolates component (C), but it fails to consider the Morita et al. reference as a whole. Component (A) of Morita et al. falls within scope of component (A) of the instant invention; however, the component (A) is not a reasonable analog to the organopolysiloxane used by Morita et al. While Applicant clearly establishes that

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the substitution yields poor results, it fails to demonstrate how the working examples compare to overall composition of Morita et al.


Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely
Patent Examiner
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PHILIP TUCKER
PRIMARY EXAMINER
ART UNIT 1712

January 20, 2004